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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/802,354 | 03/09/2001 | Steven A. Sunshine | 18564I008110 | 7440 |

22428 7590 12/22/2005

FOLEY AND LARDNER LLP
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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/802,354 | Sunshine et al. | |
| | Examiner | Art Unit | |
| | O'Connor | 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 28, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on September 28, 2005 in reply to the previous Office action on the merits, mailed June 28, 2005.
2. The amendment of claims 1, 56, 57, and 58 by applicant in the reply filed September 28, 2005 is hereby acknowledged.

Election/Restriction

3. Claims 57 and 58 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions (Inventions V and VI, respectively), there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper N^o 7.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US 6,370,513).

Kolawa et al. disclose a system for recommending a consumer product selection across a network, the system comprising: a recommendation engine comprising a first module (portion of functional descriptive material) for determining a difference between a plurality of consumer products having a plurality of descriptors by differentiating between at least one descriptor of the consumer products and providing the difference to a computer module; a descriptor module (portion of functional descriptive material) for receiving human descriptor trait (HDT) descriptor input regarding the plurality of descriptors of at least a sampled consumer product from at least two independent nodes on the network; a second module (portion of functional descriptive material) coupled to the recommendation engine for sorting between each of the consumer products to form at least two classes of the consumer products; a third module (portion of functional descriptive material) coupled to the recommendation engine for determining, for each consumer product, a correlation between the at least two classes and each of the descriptors including the received HDT descriptor input, assigning a weighting term for each descriptor

based upon the ability of each descriptor to sort between the at least two classes; and, a fourth module (portion of functional descriptive material) coupled to the recommendation engine for cooperatively operating on the weighting terms to provide a recommendation, but Kolawa et al. do not disclose that the descriptor module is configured to receive descriptor input from at least two independent consumers, since the descriptor input is received from retailers, not consumers. However, receiving feedback/reviews of products from consumers is well known to those of ordinary skill in the art (e.g., survey cards, focus groups, etc.), and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Kolawa et al. so as to receive the descriptor input from two consumers rather than two retailers, as is well known to do, in order to characterize the consumer products more accurately relative to reflecting the opinions of other consumers, as opposed to having to extrapolate from the opinions of retailers to the opinions of consumers.

Regarding claims 2-3, the nature of the particular consumer product being recommended by the system (wine, perfume, etc.) has been deemed merely a “for use” application of the claimed invention, hence, afforded little patentable weight (Kolawa et al. do, however, disclose a wine embodiment).

Regarding claim 4, each of the descriptors of the system of Kolawa et al. is (inherently) either an intrinsic (non-extrinsic) descriptor or an extrinsic (non-intrinsic) descriptor.

Regarding claims 5-6, each of the descriptors of the system of Kolawa et al. is in digital format, and is (inherently) either streaming (non-static) or static (non-streaming).

Regarding claim 7, the system of Kolawa et al. utilizes cluster mapping to generate the correlations between the consumer products and the at least two classes (see, in particular, column 12, line 35, to column 13, line 14).

Regarding claim 8, the network 12 of the system of Kolawa et al. is the Internet.

Regarding claim 56, the recited functional language characterizing the nature of the particular non-functional descriptive material being operated on by the claimed apparatus has been deemed merely intended usage of the claimed invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

Response to Arguments

7. Applicant's arguments filed Sept. 28, 2005 have been fully considered but are not persuasive.
8. Regarding the argument that Kolawa et al. do not disclose consumers being the ones to post the human descriptive trait (HDT) input, the argument is irrelevant for being non-responsive to the actual rejection, since the rejection conceded and addressed the argued omission.

9. Regarding the argument that the examiner has failed to provide a reference as evidence of what the examiner has found to be “well known” prior art, the argument has been disregarded as merely spurious, since challenging the existence of well known prior art by merely arguing that the fact is not supported by a reference, without stating for the record that the examiner is wrong or that applicant is without knowledge of the prior art teaching, does not constitute a proper traversal of the finding(s). Whereas any further traversal would no longer be seasonable, the object of the well known statement is therefore now taken to be admitted prior art. See MPEP § 2144.03.

10. Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art would include having the end users/customers post their evaluations/descriptions of the product, as other customers would tend to accept such opinions as being less biased (i.e., not being the ones selling the product and profiting from the sales).

11. Regarding the argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

December 21, 2005

 12/21/05

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

